

Appl. No. 09/902,144
Atty. Docket No. 8633
Amdt. dated April 24, 2006
Reply to Office Action of November 3, 2004
Customer No. 27752

REMARKS

Claims 1, 3-8, 11-19 and 21-24 are pending in the present application. No additional claims fee is believed to be due.

Claims 1, 8 and 17 have been amended to more specifically characterize and claim Applicant's invention. Support for these amendments are found in original Claims 8-10, and at page 3, line 27 – page 5, line 6; page 6, line 16 – page 7, line 6; page 8, line 27 – page 9, line 2; and page 12, line 9 – page 13, line 13 of the Specification.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under 35 USC 112, Second Paragraph

The Office Action States that Claims 1, 8 and 17 are rejected for failing to particularly pointing out and distinctly claiming the subject matter which the Applicant claims as its invention. The Office Action states that that Claims 1,8 and 17 recite different values (i.e., predetermined value, constant value, and optimum value), but are unclear as to how these values are being used and defined. Applicant respectfully asserts that this rejection is in error and should be withdrawn.

Applicant respectfully asserts that the definitions of the terms predetermined value, constant value, and optimum value would be obvious to one of ordinary skill in the art, in view of the Specification and Claims as originally filed. Applicant asserts that the term "optimum value" is well understood by the ordinarily skilled artisan to mean the value that is most desirable under one or more restrictions, either expressed or implied. The optimum value could be the minimum or maximum value of a given factor and set of constraints, depending on the factor to be optimized (e.g., cost factors would be minimized, return factors would be optimized, and the like). Alternatively the optimum value could be the value of a factor that minimizes or maximizes the value of another factor (e.g., the optimum amount of shelf space dedicated to a given product or product category that would maximize sales, minimize cost or combinations thereof). Support for this can be found in the Specification at page 4, line 16 – page 5, line 1; page 6, line 16 – page 7, line 6; page 7, lines 7-17; page 8, lines 4-6; page 8, lines 24-28; page 9, lines 1-7; and page 11, lines 14-16.

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With respect to the definition of "predetermined value," Applicant asserts that the term "predetermined value" is well understood by the ordinarily skilled artisan to mean a value that is already known or determined (e.g., one that does not have to be calculated contemporaneously with the calculation, determination, identification of other factors (e.g., optimum value for a given factor). One example of predetermined value could be cost data. Support for this can be found in the specification at page 4, line 16 – page 5, line 1; page 8, lines 7-18; and page 13, lines 10-12.

With respect to the definition of "constant value," Applicant asserts that the term "constant value" is well understood by the ordinarily skilled artisan to mean value for data that is constant, static and/or unchanging or a given period of time or set of analyses. Support for this can be found in the specification at page 4, line 16 – page 5, line 1 and page 11, lines 4-10.

As the definitions of the terms "predetermined value," "constant value," and "optimum value" would be obvious to one of ordinary skill in the art, in view of the Specification and Claims as originally filed, Applicant asserts that amendment of Claims 1, 8 and 17 is not required as the Claims as otherwise amended in this response already particularly point out and distinctly claim the subject matter which the Applicant claims as its invention. Accordingly Applicant respectfully suggests that continued rejection of Claims 1, 8 and 17 on these grounds would be improper, and that the rejection should be withdrawn.

Rejection Under 35 USC 101

Claims 1-6 and 8-12 and 13-24 have been rejected under 35 USC 101 as being directed towards unpatentable subject matter. The Office Action states that Applicant's claimed invention is directed to non-statutory subject matter in that the invention fails to satisfy the "technological arts" test set forth in *In re Toma*, 575 F.2d 872, 197 USPQ (BNA) 852 (CCPA 1078). Applicant has amended the instant claims to obviate this rejection and respectfully asserts that continued rejection under 35 USC 101 on these grounds would be in error.

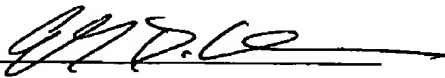
Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejections under 35 USC 101 and 35 USC 112, Second Paragraph. Early and favorable action in the case is respectfully requested.

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Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1, 3-8, 11-19 and 21-24.

Respectfully submitted,
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By 

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**REVISED AMENDMENT PRACTICE: 37 CFR 1.121 CHANGED
 COMPLIANCE IS MANDATORY - Effective Date: July 30, 2003**

All amendments filed on or after the effective date noted above must comply with revised 37 CFR 1.121. See Final Rule: *Changes To Implement Electronic Maintenance of Official Patent Application Records* (68 Fed. Reg. 38611 (June 30, 2003)), posted on the Office's website at: <http://www.uspto.gov/web/patents/ifw/> with related information. The amendment practice set forth in revised 37 CFR 1.121, and described below, replaces the voluntary revised amendment format available to applicants since February 2003. **NOTE: STRICT COMPLIANCE WITH THE REVISED 37 CFR 1.121 IS REQUIRED AS OF THE EFFECTIVE DATE (July 30, 2003).** The Office will notify applicants of amendments that are not accepted because they do not comply with revised 37 CFR 1.121 via a Notice of Non-Compliant Amendment. See MPEP 714.03 (Rev. 1, Feb. 2003). The non-compliant section(s) will have to be corrected and the entire corrected section(s) resubmitted within a set period. ***Bold underlined italic font has been used below to highlight the major differences between the revised 37 CFR 1.121 and the voluntary revised amendment format that applicants could use since February, 2003.*** Note: The amendment practice for reissues and reexamination proceedings, except for drawings, has not changed.

REVISED AMENDMENT PRACTICE

I. Begin each section of an amendment document on a separate sheet:

Each section of an amendment document (e.g., Specification Amendments, Claim Amendments, Drawing Amendments, and Remarks) must begin on a separate sheet. Starting each separate section on a new page will facilitate the process of separately indexing and scanning each section of an amendment document for placement in an image file wrapper.

II. Two versions of amended part(s) no longer required:

37 CFR 1.121 has been revised to no longer require two versions (a clean version and a marked up version) of each replacement paragraph or section, or amended claim. Note, however, the requirements for a clean version and a marked up version for substitute specifications under 37 CFR 1.125 have been retained.

A) Amendments to the claims:

Each amendment document that includes a change to an existing claim, cancellation of a claim or submission of a new claim, must include a complete listing of all claims in the application. After each claim number in the listing, the status must be indicated in a parenthetical expression, and the text of each pending claim (with markings to show current changes) must be presented. The claims in the listing will replace all prior claims in the application.

(1) The current status of all of the claims in the application, including any previously canceled, not entered or withdrawn claims, must be given in a parenthetical expression following the claim number using only one of the following seven status identifiers: (original), (currently amended), (canceled), (withdrawn), (new), ***(previously presented) and (not entered).*** The text of all pending claims, ***including withdrawn claims,*** must be submitted each time any claim is amended. Canceled ***and not entered*** claims must be indicated by only the claim number and status, without presenting the text of the claims.

(2) The text of all claims being currently amended must be presented in the claim listing with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) ***for deletion of five characters or fewer, double brackets may be used (e.g., [[error]]); and (2) if strikethrough cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., [[4]]).*** As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change (e.g., number 4 as number 14 as). An accompanying clean version is not required and should not be presented. Only claims of the status "currently amended," and "withdrawn" that are being amended, may include markings.

(3) The text of pending claims not being currently amended, ***including withdrawn claims,*** must be presented in the claim listing in clean version, i.e., without any markings. Any claim text presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version except to omit markings that may have been present in the immediate prior version of the claims.

06/30/03 Flyer for mailing with all Office actions by all TCs (4) A claim being canceled must be listed in the claim listing with the status identifier "canceled"; the text of the claim must not be presented. Providing an instruction to cancel is optional.

(5) Any claims added by amendment must be presented in the claim listing with the status identifier "(new)"; the text of the claim must not be underlined.

(6) All of the claims in the claim listing must be presented in ascending numerical order. Consecutive canceled, or not entered, claims may be aggregated into one statement (e.g., Claims 1 - 5 ((canceled))).

Example of listing of claims (use of the word "claim" before the claim number is optional):

Claims 1-5 (canceled)

Claim 6 (previously presented): A bucket with a handle.

Claim 7 (withdrawn): A handle comprising an elongated wire.

Claim 8 (withdrawn): The handle of claim 7 further comprising a plastic grip.

Claim 9 (currently amended): A bucket with a green blue handle.

Claim 10 (original): The bucket of claim 9 wherein the handle is made of wood.

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Claim 11 (canceled)
Claim 12 (not entered)
Claim 13 (new): A bucket with plastic sides and bottom.

B) Amendments to the specification:

Amendments to the specification, including the abstract, must be made by presenting a replacement paragraph or section or abstract marked up to show changes made relative to the immediate prior version. An accompanying clean version is not required and should not be presented. Newly added paragraphs or sections, including a new abstract (instead of a replacement abstract), must not be underlined. A replacement or new abstract must be submitted on a separate sheet, 37 CFR 1.72. If a substitute specification is being submitted to incorporate extensive amendments, both a clean version (which will be entered) and a marked up version must be submitted as per 37 CFR 1.125. The changes in any replacement paragraph or section, or substitute specification must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for *deletion of five characters or fewer, double brackets may be used (e.g., [[error]])*; and (2) *if strikethrough cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., [[4]])*. As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change (e.g., number 4 as number 14 as)

C) Amendments to drawing figures:

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment, *and may be accompanied by a marked-up copy of one or more of the figures being amended, with annotations*. Any replacement drawing sheet must be identified in the top margin as "Replacement Sheet" and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. *Any marked-up (annotated) copy showing changes must be labeled "Annotated Sheet Showing Changes" and accompany the replacement sheet as an appendix to the amendment*. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified. Questions regarding the submission of amendments pursuant to the revised practice set forth in this flyer should be directed to: Elizabeth Dougherty or Gena Jones, Legal Advisors, or Joe Narcavage, Senior Special Projects Examiner, Office of Patent Legal Administration, by e-mail to patent.practice@uspto.gov or by phone at (703)305-1616.
06/30/03 Flyer for mailing with all Office actions by all TCs